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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,057	06/26/2001	Roberto Alcantara Martins Zucchetti	32286R006	6856

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EXAMINER

HENLEY III, RAYMOND J

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,057

Applicant(s)

ZUCCHETTI ET AL.

Examiner

Raymond J Henley III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

CLAIMS 1-20 ARE PRESENTED FOR EXAMINATION

Applicants' Amendment filed March 17, 2004 (a copy of the Response filed February 9, 2004) has been received and entered into the application. Accordingly, claims 5 and 10 have been amended.

Claim Rejection - 35 USC § 112, Second Paragraph

Claims 5 and 8-18 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons of record as set maintained in the previous Office action dated September 9, 2003, as applied to claims 5-18.

The rejection of claims 6 and 7 is withdrawn. These claims depend from claim 1 and do not depend from or include the terms held to be indefinite.

Applicants' arguments have been carefully considered, but fail to persuade the Examiner of error in his determination of indefiniteness.

In particular, applicants have argued that in the cosmetic industry, the terms "skin structures", "micronutrients of the skin" and "sensory agents" would be understood and thus the terms are not indefinite.

The Examiner maintains that the skilled artisan would not be reasonably apprised of the metes and bounds of the claimed subject matter such that the artisan would know whether a particular substance would fall within or outside the meaning of the terms "skin structures", "micronutrients of the skin" and "sensory agents" as employed by applicants.

Applicants have argued that the specification gives examples of “skin structures”, “micronutrients of the skin” and “sensory agents”.

Respecting “skin structures”, the specification merely sets forth “skin structures, preferably [sic] squalan and [sic] sphingolipide” (page 5, lines 16-17). The listing of two compounds does not provide an adequate basis for concluding that the metes and bounds of the term “skin structures” would be clear. In particular, it is not clear what type of skin is intended, i.e., anatomical location or even the species of skin. Could the term encompass a piece of skin? The normal definition of the term structure is something made up of a number of parts held or put together in a specific manner. Does the term encompass “structures” found only in certain species of skin-bearing animals? What kind of “structures” are intended? The term is still deemed ambiguous by the Examiner.

Respecting “micronutrients of the skin”, the specification merely sets forth “micronutrients of the skin, preferably seaweed extract” (page 5, line 17). Again, the specification does not mention what kind of skin in terms of anatomical location or species and the composition of skin in various species would be expected to vary widely.

Respecting the term “sensory agents”, the specification merely sets forth “moisteners such as glycerin and hydroxy [sic] prolisilan C, emollients such as [sic] butylene glycol and [sic] cethyl lactate and silicones such as cyclomethicone”. Not only are several terms here misspelled, but the list of ingredients does not set a standard such that the skilled artisan would be reasonably apprised of what agents are within and not within the scope of the term “sensory agent”. In support of this position, the Examiner points out that from reading of the specification, it appears that only agents that are moisteners, emollients or silicones would be included. Applicants, however, have relied

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upon an internet site where “fragrance” is offered as a sensory agent. The concept of a fragrance being a sensory agent, however, is completely lacking in the specification. Indeed, that a fragrance is not intended by applicants as a “sensory agent” is clear from page 5 of the present specification, at line 24 where “fragrances” are listed as a separate category of additional ingredients. However, applicants have now argued that a fragrance would be included in the term “sensory agent”. The term is deemed ambiguous.

Accordingly, for the above reasons, the claims are deemed to remain properly rejected.

Claim Rejection - 35 USC § 103

Claims 1-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Rinaldi et al. (U.S. Patent No. 5,891,470) in view of Huc et al. (U.S. Patent No. 5,395,620), each of record, for the reasons of record as set forth in the previous Office action.

Applicants’ arguments at pages 7-10 of their amendment have been carefully considered, but fail to persuade the Examiner of error in his determination of obviousness.

In particular, applicants have urged at page 8 of the amendment:

“The invention claimed in the present patent application actually refers to the synergy between the ascorbic acid and retinol in the cellular activity. This effect is shown in the Figures and described in the instant specification. This effect was surprisingly detected by the present inventors since there was no indication of such technical result in the literature.”

In response thereto, the Examiner has noted the specification and the Figures. However, as stated by applicants, synergy is only “referred” to therein. The specification and Figures are inadequately detailed with respect to ingredients amounts, treatment

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protocols, materials, environment, statistical significance of the results etc. that the Examiner cannot reach a reasoned conclusion respecting the probative value thereof in relation to the claimed subject matter.

At page 9 of the Amendment, applicants have further argued:

“Rinaldi does not show nor foresee the actual way of action disclosed in the present application nor the way the microcapsules are indeed used. In other words, as conceded in the Office Action, the microparticles employed by Rinaldi are not the same as the microparticles used in the present invention. In fact, the microparticles used by Rinaldi have very different properties from those used in the present invention.”

In response to applicant's argument that the “way of action” taught by Rinaldi is not that of applicants, it is the Examiner's position that the fact that applicants have recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Further, the present claims are directed to compositions of matter and not methods of use, accordingly, the arguments concerning “the way the microcapsules are indeed used” is neither germane to nor commensurate in scope with the instant determination of obviousness. Finally, insofar as the present claims merely require that the microparticles are made of biologically active material, it is not fully agreed that the microparticles of Rinaldi are not within the scope of the present claims. The microparticles of Rinaldi act not only as a carrier for the vitamins but also have vitamins impregnated within in them, thus they are made of biologically active materials.

Also at page 9 of the Amendment, applicants have argued that the Examiner has improperly applied hindsight reconstruction to render the conclusion that the claimed

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subject matter would have been obvious. In response thereto, the Examiner contends that it must be recognized that any judgment on obviousness is, in a sense, necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Finally, at page 10 of the Amendment, applicants have argued that the concentrations of Vitamin A and C present in the claims would not have been suggested by Rinaldi. It is first noted, however, that not all claims are limited to specific amounts. Those claims which employ functional language, i.e., "an amount effective for enhancing the action of.." are interpreted in light of the specification and other claims to include those concentrations specifically disclosed and claimed. Insofar as Rinaldi teaches that the capsule fill material will have a typical retinol content of at least 0.005% (col. 6, line 38) and a typical ascorbic acid content of at least 0.01% (col. 6, line 43), applicants' arguments are not well taken.

Accordingly, for the above reasons, the claims are deemed properly rejected and none are allowed.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not


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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J Henley III whose telephone number is 571-272-0575. The examiner can normally be reached on M-F, 8:30 am to 4:00 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Raymond J Henley III
Primary Examiner
Art Unit 1614

July 20, 2004